

REMARKS

Applicants have canceled claims 25-31 and amended claim 1. Support for this amendment can be found throughout the specification and claims as filed. Specifically, support may be found, for example, at pages 86-88, paragraphs [0360-0363]. No new matter has been added by way of amendment. Claims 1-5, 7 and 23 will be pending upon entry of the instant amendment.

Specification

The Examiner objected to the abstract of the disclosure because the interpretation of the numerical identifier 8263 can be misinterpreted as eight thousand two hundred and sixty-three genes that were analyzed for differential expression. To address the Examiner's concern, Applicants have replaced the identifier "8263 genes" in the abstract with the term, "Carboxypeptidase 8263 transcripts". Applicants submit that this amendment correctly and unambiguously describes the invention, while maintaining the use of the Applicants' original identifier 8263. Applicants respectfully request reconsideration and withdrawal of the objection.

**The Rejection of Claims 1-4, 7, 23, 25-28, 30, and 31 under 35 USC §102(b) and the
Rejection of Claims 1-5, 7, 23, and 25-31 under 35 USC §102(e)
Should Be Withdrawn**

The Examiner rejected claims 1-4, 7, 23, 25-28, 30, and 31 under 35 USC §102(b) as being anticipated by Song and Fricker (J Biol Chem, 272(16): 10543-10550, 1997). The Examiner also rejected claims 1-5, 7, 23, and 25-31 under 35 USC §102(e) as being anticipated by Mack et al. (U.S. Patent Application, Publication No. 2004/0076955 A1). In response to Applicants' previous arguments, the Examiner stated,

"the recitation of 'capable of treating urinary incontinence' and 'capable of treating benign prostatic hyperplasia' have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not

depend on the preamble for completeness, but instead, the process steps or structural limitations are able to stand alone.”

The Examiner continued,

“Song and Fricker disclose a method of combining a compound, particularly an active site-directed inhibitor with Carboxypeptidase Z, therefore the inhibitor would be expected to bind the enzyme, Carboxypeptidase Z (current application, SEQ ID NO:104). Therefore, Song and Fricker anticipate the method currently being claimed. In addition, Mack et al. also disclose the method for identifying a compound comprising the steps of contacting a compound with Carboxypeptidase Z and determining the functional effects on Carboxypeptidase Z (see 102(e) rejection above for citation). Thus, Mack et al anticipates the method currently being claimed.”

Applicants have canceled claims 25-31 and amended claim 1 to recite the step, “determining the effect of the compound on urinary incontinence in an animal model of urinary incontinence”. Applicants submit that since neither Song and Fricker nor Mack et al. make any mention of urinary incontinence or a step of determining the effect of the compound in an animal model of urinary incontinence, then neither reference anticipates the method of the claims as amended. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-4, 7, 23, 25-28, 30, and 31 under 35 USC §102(b) and the rejection of claims 1-5, 7, 23, and 25-31 under 35 USC §102(e).

CONCLUSIONS

In view of the amendments and remarks made herein, Applicants respectfully submit that the objections and rejections presented by the Examiner are now overcome and that this application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely as a request for a two month extension of time is filed concurrently herewith. No additional extensions of time are required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

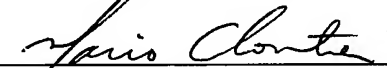
Entry of the remarks made herein is respectfully requested.

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Respectfully submitted,

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